

REMARKS

The present Amendment is filed in response to the Notice of Non-Compliant Amendment under 37 CFR 1.121 dated August 18, 2009.

Claims 1–18 are pending. Claims 9–16, 18, and 19–40 are currently canceled. Claim 1 is currently amended. Reconsideration of the application is requested.

§ 112 Rejections

Claims 1, 8, 9, 11, 12, and 16 are rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirements.

Claims 1 and 8 are amended to remove the term "solid". Claims 9, 11, 12 and 16 are currently cancelled.

In summary, Applicants submit that the rejection of claims 1 and 8 under 35 USC § 112, first paragraph, has been overcome, and that the rejection should be withdrawn. The rejection of claims 9, 11, 12 and 16 under 35 USC § 112, first paragraph is now moot.

Drawings

The drawings are objected to for assertedly failing to show a solid tip as claimed. While Applicants continue to disagree with the Patent Office regarding this point, nonetheless, Applicants have cancelled that term from the claims and therefore respectfully submit that the objection to the claims is now moot.

§ 102 Rejections

Claims 1–18 are rejected under 35 USC § 102(e) as being anticipated by Sherman (US 2002/0020688).

The Patent Office continues to assert that Sherman discloses a microneedle that "can comprise" a flat tipped microneedle at paragraph 0088. Further, the Patent Office asserts that Sherman discloses the tip as being "capable of" comprising "an area of between 20 and 100 square micrometers and the base are capable of being 900 square micrometers or more".

First, the Patent Office uses language that implies that Sherman does not necessarily describe the features asserted by the Patent Office. Disclosing a microneedle tip that is "capable of comprising an area of between 20 and 100 micrometers" is not the same as disclosing a microneedle having a tip with an area of between 20 and 100 square micrometers. Applicants request clarification from the Patent Office as to whether the assertion is that Sherman actually

teaches such microneedles or whether the Patent Office asserts that Sherman teaches needles that are capable of meeting the limitations of the claims, but is in fact silent as to the claimed aspects.

Regardless, the Patent Office has failed to respond to an important distinction between the claimed invention and the described microneedles of Sherman, and therefore has failed to substantiate the rejection of the claims over Sherman. In particular, claim 1 requires that the microneedles have a flat tip and that the "flat tip comprises a ***surface area*** measured in a plane aligned with the base of 20 square micrometers or more and 250 square micrometers or less". Claim 8 requires that the "flat tip comprises a ***surface area*** measured in a plane aligned with the base of 20 square micrometers or more and 100 square micrometers or less".

As presented in Applicants response filed on April 29, 2009, even if Sherman were construed to disclose a flat tip, it does not disclose a surface area as claimed. Indeed, the Patent Office seems to recognize this in the Office Action. The Patent Office asserts that Sherman discloses a flat tip capable of comprising an "area" within a given range. The Patent Office avoids using the term "surface area", recognizing that a hollow bore bears only a surface on its perimeter, and therefore that Sherman at most discloses the cross-sectional area of the hollow opening to be within a certain range, but Sherman most certainly does not disclose a ***surface area*** within that range.

The rejection of independent claims 1 and 8 under 35 USC § 102(e) as being anticipated by Sherman has been overcome and should be withdrawn. Dependent claims 2–7 each add patentable features to independent claim 1 and are therefore not anticipated by Sherman for at least the reasons discussed above with regard to claim 1.

In view of the above, it is submitted that the application is in condition for allowance. Examination and reconsideration of the application as amended is requested.

Respectfully submitted,

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Date

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